



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/550,583	04/17/2000	YAARIT SILVERSTONE	AND1P584	1125

7590 06/17/2003

OPPENHEIMER WOLFF & DONNELLY LLP
Plaza VII, Suite 3300
45 South Seventh Street
Minneapolis, MN 55402

EXAMINER

AKERS, GEOFFREY R

ART UNIT	PAPER NUMBER
----------	--------------

3624

DATE MAILED: 06/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application 09/550583	Applicant(s) Silverstein	
	Examiner Akers, G	Art Unit 3624	Confirmation No.

- The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address -

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 5/28/03
- ☐ This action is FINAL. ☒ This action is non-final.
- ☐ Since this application is in condition for allowance except for the formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-14, 22-27 is/are pending in this application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-14, 22-27 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved or ☐ disapproved by the Examiner. If approved, corrected drawings are required in reply to this Office action.
- ☐ The drawing(s) filed on _____ is/are ☐ accepted or ☐ objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d) or (f).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- *Certified copies not received:
- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- ☐ The translation of the foreign language provisional application has been received.
- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Art Unit: 3624

DETAILED ACTION

Response to Request for Continued Examination(RCE)

1. This action is issued in response to applicant's Request for Continued Examination (RCE)(Paper#14) and Amendment A(Paper #16) filed 5/26/03.
2. Claims 15-21 were cancelled. Independent claims 1,8 were amended. New claims 22-27 were added.
3. Claims 1-14,22-27 are pending.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2, 6-9,13-14,22-23,26-27 are rejected under 35 USC 103(a) as unpatentable over Sheflott(US Pat. No: 5,802,493) in view of Tibbetts (US Pat. No: 6,158,044) and further in view of Flores(US Pat. No: 6,073,109).
6. As per claims 1,8,15,22 Sheflott teaches a method for providing a contract services in a framework comprising the steps of matching a user to a service provider utilizing a database having information on service providers(Abstract)(Fig 1/21/36/30)(Fig 3/88)(col 6 lines 55-62) and providing supply chain/workflow services and a database for services provided by the service

Art Unit: 3624

providers and identifying a particular service provider based on the request data(col 6 lines 32-52)(col 6 lines 62-col 7 line 3) and sending the user information concerning process design services using the service provider data structure(col 7 lines 15-67)(Fig. 4)and allowing the user access and query for technical services concerning services provided by the service providers utilizing the database(col 23 lines 22-30). Flores teaches providing transaction services to the user(Fig 4c)(Fig 4b)(Fig 4a)(col 110 lines 27-64).Flores fails to specifically teach utilizing a request for proposal mechanism. Tibbetts teaches utilizing a request for proposal mechanism(Fig 5)(Fig 7). Sheflott does not specifically apply his methods to a contract manufacturing environment.It would have been obvious to one skilled in the art at the time of the invention to combine Sheflott in view of Tibbetts and further in view of Flores to teach the above and to apply these techniques to a contract manufacturing enviroment. The motivation to combine is to teach an architecture that takes advantage of thegeneric properties permitting it to be reusable for new types of transactions as enunciated by Tibbetts(col 1 lines 53-56). The further motivation to combine is to teach a system for analyzing and structuring business processes that provides clients with the requistire tools to manage these businesses efficiently as enunciated by Flores(col 1 lines 19-22).

7. As per claims 2,9,16,23 Sheflott teaches a method as recited in claim 1,8,15,22 respectively wherein the step of matching the user to a service provider includes optimization services(Fig 3/101/100/90).

Art Unit: 3624

8. As per claims 6,13,20,26 Sheflott teaches a method as recited in claims 1,8,15,22 wherein the database is accessed using a network(Fig 3)(Fig 6)(col 8 line 63-col 9 line 32).

9. As per claims 7,14,21,27 Sheflott teaches a method as recited in claims 1,8,15,26 where the network is the Internet(Fig 15/312)(col 21 lines 10-25).

10. Claims 3-5, 10-12,24 are rejected under 35 USC 103(a) as unpatentable over Sheflott(US Pat. No: 5,802,493) in view of Tibbetts (US Pat. No: 6,158,044) and further in view of Flores(US Pat. No: 6,073,109) and further in view of Elance.com(1999).

11. As per claims 3,10,24 Sheflott teaches according to the method as recited in claims 2,9,16 respectively using technical experts(Fig 4/180). Sheflott fails to teach wherein the step of providing supply chain/workflow services includes identifying particular service provider information. Flores teaches (Fig 2)(col 6 lines 15-col 7 line 5)(Fig 2) based on a request for proposal from the user utilizing the request for proposal mechanism, and affording project management services to the user based on the request for proposal and the identified service provider information(col 8 lines 47-59).Flores fails to specifically teach utilizing a request for proposal mechanism.Tibbetts teaches a request for proposal mechanism(Fig 7)(Fig 5)(col 4 lines 15-34). Finally, Elance.com teaches the specific use of legal services(page 2). It would have been obvious to one skilled in the art at the time of the invention to combine Sheflott in view of Tibbetts and further in view of Flores and further in view of Elance to teach the above. The motivation to combine is to teach an architecture that takes advantage of the generic properties

Art Unit: 3624

permitting it to be reusable for new types of transactions as enunciated by Tibbetts(col 1 lines 53-56). This further motivation to combine is to teach a system for analyzing and structuring business processes that provides clients with the requisite tools to manage these businesses efficiently as enunciated by Flores(col 1 lines 19-22). Finally, the motivation to combine is to teach a system capable of delivering legal services as taught by Elance.

12. As per claims 4,11,18 Sheflott teaches a method as recited in claims 1,8,15 respectively where the technical experts available for consultation services include consulting services(Fig 4/136/180/138).Sheflott teaches contact and consultation with technical experts(Fig 4/180). Sheflott fails to teach that these services specifically relate to engineering services. Flores teaches a method as recited in claim 1, wherein the step of allowing the user access to technical services includes identifying particular service provider information based on a request data from the user(Fig 2)(col 6 line 50-col 7 line 5), wherein the particular service provider information includes information concerning process design services, and sending the user data concerning process design services utilizing the identified service provider information(col 11 line 1-24)(col 9 line 41-col 10 line 67).Furthermore,Elance.com teaches utilization of patent licensing(p. 4,6). It would have been obvious to one skilled in the art at the time of the invention to combine Sheflott in view of Tibbetts and further in view of Flores and further in view of Elance.com to teach the above and to apply the consultations with patent experts and with patent licensing. The motivation to combine is to teach an architecture that takes advantage of the generic properties permitting it to be reusable for new types of transactions as enunciated by Tibbetts(col 1 lines 53-

Art Unit: 3624

56). This further motivation to combine is to teach a system for analyzing and structuring business processes that provides clients with the requisite tools to manage these businesses efficiently as enunciated by Flores(col 1 lines 19-22). Finally, the motivation to combine Elance in view of Sheflott in view of Tibbets in view of Flores is to teach a system capable of permitting a user to request information on patent licensing.

13. As per claims 5,12,19 Sheflott teaches a method as recited in claims 1,8,15 respectively where the technical experts available for consultaton services include consulting services(Fig 4/136/180/138).Sheflott teaches contact and consultation with technical experts(Fig 4/180). Sheflott fails to teach that these services specifically relate to engineering services. Flores reaches a method as recited in claim 1, wherein the step of allowing the user access to technical services includes identifying particular service provider information based on a request data from the user(Fig 2)(col 6 line 50-col 7 line 5), wherein the particular service provider information includes information concerning process design services, and sending the user data concerning process design services utilizing the identified service provider information(col 11 line 1-24)(col 9 line 41-col 10 line 67).Furthermore,Elance.com teaches utilization of multi-country patent licensing(p. 7,9). It would have been obvious to one skilled in the art at the time of the invention to combine Sheflott in view of Tibbetts and further in view of Flores and further in view of Elance.com to teach the above and to apply the consultations with patent experts and with multi-country patent licensing. The motivation to combine is to teach an architecture that takes advantage of the generic properties permitting it to be reusable for new types of transactions as

Art Unit: 3624

enunciated by Tibbetts(col 1 lines 53-56). This further motivation to combine is to teach a system for analyzing and structuring business processes that provides clients with the requisite tools to manage these businesses efficiently as enunciated by Flores(col 1 lines 19-22). Finally, the motivation to combine Elance in view of Sheflott in view of Tibbetts in view of Flores is to teach a system capable of permitting a user to request information on multi-country patent licensing.

Response to Arguments

14. Applicant's arguments with respect to all claims have been considered but are not persuasive. Elance was founded in 1998(Exhibit A). The date of printing from the website is irrelevant to the date of reduction to practice of Elance's activities which predate the applicant's disclosure. Tibbetts teaches providing transaction services including the logic for creating a request for proposal utilizing the request for proposal mechanism and the logic for routing a request for proposal utilizing the request for proposal mechanism(Abstract)(Fig 5/503/502)(Fig 7/707/708)(col 4 lines 15-34) and logic for routing a request for proposal utilizing the request for proposal mechanism(col 5 lines 14-27). Flores further teaches workflow service(Abstract)(col 110 lines 27-62)(col 3 lines 49-52)(col 4 lines 64-67)(col 5 line 1-col 6 line 49). Additionally, Tibbetts teaches workflow processes as applied in the proposal based architecture(col 7 lines 3-17).

Sheflott teaches sending the user identified service provider information(col 6 lines 55-col 7 line 12) including provider product adequacy(col 6 line 66) as well as percentage saturation of providers is important in assessing competition(col 6 line 67-col 7 line 3). Tibbetts teaches

Art Unit: 3624

defining a set of specifications for all proposal components(col 42 line 49) and proposal submission(col 44 lines 7-10).Flores teaches identifying service provider based on the request for proposal in designated data fields(col 46 lines 36-col 47 line 12)(col 105 line 39)(col 106 lines 11-14)(col 106 lines 57-58)(col 107 line 9)(RFP:col 105 line 1-col 107 line 14).Sheflott teaches a request for information(col 3 lines 59-61) and the generation of a response document(col 3 line 65-col 4 line 38)(Fig 1) as well as identifying the particular service provider information based on a request for proposal(col 5 lines 37-col 6 line 9)(Fig 1/21)(col 5 lines 52-55)(col 6 line 65-66) as well as project management services based upon a request for proposal(col 9 line 41)(col 9 lines 34-67).Sheflott teaches allowing the user to access technical services(col 14 line 62-65)(col 21 line 24-col 22 line 5)(Fig 15/314)(col 6 lines 32-52).Sheflott teaches noncompetitive bids(col 5 line 65-col 6 line 3) and preparation of materials for a broker and that RFP specifications and responses are delivered through brokers by bidders(col 5 lines 21-25)(col 5 line 31-34).This relationship by its nature is confidential and implies a nondisclosure arrangement. Tibbetts teaches accessing a database utilizing a network(Fig 5)(Fig 7)(Fig 10)(Fig 12) and that the proposal is not tied to any specific platform or machine(col 7 lines 45-57) which may include a network. Tibbetts teaches allowing a user to add a web-based interface(col 2 lines 18-23) which would utilize a network. Flores also teaches that databases are accessible by the workflow server and accessible by users through a network interface(col 9 lines 6-37).Finally, Sheflott discloses an access database accessible through e-mail, which may incorporate a network(Fig 15/308/298/312)(Fig 6)(col 19 line 56-col 20 line 12).Sheflott teaches process design

Art Unit: 3624

services(col 9 line 41) and Flores teaches workflow processes(col 5 line 1-col 6 line 49) as well as business processes(col 6 lines 20-32) where users can define the links that constitute a business or design process(col 6 lines 22-24).

Conclusion

15. **THIS ACTION IS MADE NON-FINAL.**

16. Any questions concerning this communication should be addressed to the examiner of record, Dr. Geoffrey Akers, P.E., who can be reached between 6:30 AM and 5:00 PM Monday through Friday at 703-306-5844. If attempts to contact the examiner are unsuccessful, the examiner's superior, Mr. Vincent Millin, SPE, may be telephoned at (703)-308-1065.

The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 3600 or this Art Unit is (703)-308-3687. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)-308-1113.

GRA


June 15, 2003

DR. GEOFFREY R. AKERS, P.E.
PRIMARY EXAMINER